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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROYASU KOKUBO and SAKAE OBARA

Appeal 2010-010550
Application 09/842,466
Technology Center 1600

Before ERIC GRIMES, JEFFREY N. FREDMAN, and
STEPHEN WALSH, *Administrative Patent Judges*.

WALSH, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

Hiroyasu Kokubo and Sakae Obara (Appellants) request rehearing under 37 C.F.R. § 41.52 of the Decision on Appeal entered April 12, 2010, which affirmed a rejection of all the pending claims for obviousness.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

ISSUES

The Request for Rehearing presents two issues:

- (1) “the Board erred as a matter of fact in finding that Hogan teaches a multi-colored and continuous coating” (Req. Reh’g 1-2); and
- (2) “the Board erred in not separately addressing the patentability of” claims 18-20 and 44-47, which recite that the pattern comprises a logo, barcode, or letters. (*Id.* at 2.)

ISSUE 1

We adhere to our Decision that the evidence supports the finding that Hogan taught a multi-colored and continuous coating.

The Request argues that this issue “basically turns on whether the multi-colored coating in Hogan can be considered continuous.” (Req. Reh’g 2.) Appellants argue that “it cannot be [continuous] for the same reasons the coating of Berta cannot be considered continuous.” (*Id.*) In the Decision, we found that Berta formed the coating by dipping, and explicitly taught that the coating would have a seam. (E.g., Dec. 4, FF 2.) Because Berta’s coating was expressly described as having a seam, we found it was not continuous in the ordinary sense of the term. (Dec. 7.)

Hogan did not teach forming a coating by dipping and did not teach that the coating has a seam. Hogan explicitly taught that its coating was “continuous,” using exactly that word to describe it. (Dec. 5, FF 8, 9.) Appellants contend that Hogan’s description of producing a multi-colored tablet “is very similar to the first step in the two-dip process described in Berta, which the Board agreed did not produce a continuous coating.” (Req. Reh’g 3.) As Appellants note, however, after Hogan applied two different colorants electrostatically, Hogan then exposed the tablet to heat or

electromagnetic radiation. (*Id.*) According to Hogan, exposure to heat or radiation forms a continuous coating. (Dec. 5, FF 8, 9.) Hogan's process was different from Berta's. We see no evidence that, contrary to Hogan's explicit teaching, the coating on Hogan's tablet would not have been continuous.

We are also not persuaded by the additional arguments that Hogan did not teach a continuous multi-colored coating. (Req. Reh'*g* 3-4.) Where Hogan taught that different faces of the tablet could have different colors (Dec. 6, FF 11), we find no indication that, contrary to Hogan's teaching of a continuous coating, the multi-colored embodiment did not have a continuous coating. FF 11 quoted only part of Hogan, col. 12, ll. 30-44, to which the Examiner had referred. (*Compare* FF 11 with Ans. 5 and Hogan, col. 12, ll. 30-44.) The omitted portion of the sentence quoted partially in FF 11 reads in full: “[i]n that way a coating may easily be provided over the entire surface of the tablet core, and different coating materials may be used for coating different parts of the core.” We again find this a disclosure of one coating over the entire surface; the one coating may be multi-colored, and it is continuous.

ISSUE 2

We erred by not separately addressing claims 18-20 and 44-47. Appellants correctly point out that the Appeal Brief presented separate arguments for claims 18-20 and 44-47 (App. Br. 10-11), and our Decision overlooked it (Req. Reh'*g* 4-5). We address the overlooked arguments now.

Claims 18-20 and 45-47 define preparations having a pattern comprising a logo, bar code, or letters. Claim 44 defines a preparation having a pattern of two or more colors. Claim 18 is representative of the

separately argued claims 18-20 and 45-47. Claim 18 depends from claim 17, which in turn depends from claim 31. Incorporating claims 31 and 17, claim 18 reads:

18. [A solid preparation coated with a multi-colored continuous film coating layer, prepared by the process of
 - coating a solid preparation with a continuous film coating layer having one or more colorants; and,
 - exposing a first part of the coating layer to a first amount of radiation and exposing a second part of the coating layer to a second amount of radiation under conditions sufficient to result in the first and second parts of the coating layer having different coloration;
 - wherein said film coating layer has a pattern of two or more different colors;]
 - wherein said pattern comprises a logo.

The Issue

The Examiner found that Berta did not teach a logo, letters, or a bar code on the medicament, but found they were routinely used. (Ans. 4.) According to the Examiner, “[w]hile the combin[ed] references do not explicitly state the use of logos, patterns, or bar codes, the inclusion of such would provide for an aesthetically pleasing appearance as well as for easier identification of tablets, as is well known to one of ordinary skill in this art.” (Ans. 11.)

Appellants contend that the rejection “completely fails to disclose how such a coating could be obtained by modifying the cited references.” (App. Br. 10.)

Principles of Law

“Obviousness does not require absolute predictability of success. . . . [A]ll that is required is a reasonable expectation of success.” *In re O'Farrell*, 853 F.2d 894, 903-04 (Fed. Cir. 1988).

Analysis

Because Appellants object that the rejection does not disclose “how” a coating with a logo could be obtained, we have reviewed the record for guidance on that technique in the prior art. We find none. It may be, as the Examiner found, that logos, etc., would have aesthetic and identification advantages. (Ans. 11.) However, without further evidence or explanation from the Examiner on this record, there is insufficient evidence to support finding a reasonable expectation of success in so modifying the prior art preparations.

Claim 44 defines a preparation having a pattern of two or more colors, and stands separately from claim 18. We find that Hogan’s example of different colors on the each of the opposite faces of a tablet disclosed a pattern of two or more colors. (Dec. 6, FF 11.) The disclosure in Hogan’s patent is presumed enabled. *See Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003). Appellants have not met the burden of showing that Hogan’s teaching of a tablet with different colors on the opposite faces was not enabled, and that there would not have been a reasonable expectation of success in following Hogan’s teaching.

CONCLUSIONS

We have reconsidered Hogan’s disclosure, but again find the evidence supports the Examiner’s finding that Hogan taught a continuous film layer with at least two differently colored parts.

The rejection provided insufficient evidence or explanation to support finding a reasonable expectation of success in modifying the prior art to produce a tablet with a pattern comprising a logo, a bar code, or pattern of letters.

SUMMARY

We reaffirm the rejection of claims 6-9, 11, 13-17 and 31-44 under 35 U.S.C. § 103 over Berta and Hogan.

We reverse the rejection of claims 18-20 and 45-47 under 35 U.S.C. § 103 over Berta and Hogan.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REHEARING GRANTED-IN-PART

cdc

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